

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

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PARTIDO REVOLUCIONARIO DOMINICANO  
(PRD) Seccional Metropolitana de Washington-DC,  
Maryland y Virginia, et al.,

Plaintiffs,

v.

“PARTIDO REVOLUCIONARIO DOMINICANO,  
Seccional de Maryland y Virginia,” et al.,

Defendants/Counterclaimants.

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) Civil Action No. 01-1359 (PLF)  
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OPINION

This matter came before the Court for a bench trial on the parties’ cross-motions for a permanent injunction. The dispute relates to which party has the right to use in the Washington, D.C. metropolitan area the name and insignia associated with one of the three major political parties in the Dominican Republic, the Partido Revolucionario Dominicano (“PRD”). Plaintiffs contend that defendants have intentionally created confusion among individuals who are interested in Dominican political issues by using the name and insignia of the PRD in an unauthorized manner, which use has caused and will continue to cause irreparable harm to their group -- the first group to use the PRD name and insignia. Plaintiffs claim a violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and common law trademark infringement. Defendants filed counterclaims on similar grounds, but in defendants’ favor. Both parties seek permanent injunctive relief.

A bench trial took place over three days in the Fall of 2002. At the trial, plaintiffs called as witnesses members of plaintiffs' organization, President Hector Santos and Organizational Secretary Andreas Beriguete. They also called as adverse witnesses President Franklin Jimenez and Vice President Guillermo Rivera of defendants' organization and offered the deposition testimony of Dr. Rafael Bonilla, Secretary of the PRD in the Dominican Republic and a former Cabinet Minister in the Dominican Republic. Plaintiffs then called Shelley Blumberg Lorenzana as an expert witness in translation to translate two documents plaintiffs offered in evidence. In their case-in-chief, defendants called as witnesses Vice President in Function Felipe Rodriguez, Mr. Rivera and Secretary General Ivan Romero, all from defendants' organization, and Dr. Rafael Lantigua, who is the Federal President of the PRD for the United States, Canada and Puerto Rico. In addition, the Court accepted in evidence numerous documents offered in support of the parties' claims.<sup>1</sup> After carefully considering the briefs and arguments of counsel for the parties in support of their cross-motions for permanent injunctive relief, the testimony of the witnesses at trial and the admitted documentary evidence, the Court concludes that plaintiffs are entitled to injunctive relief and that defendants are not. It therefore will grant plaintiffs' motion and will deny the motion of defendants.

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<sup>1</sup> Upon consideration of the arguments presented in post-trial briefs, the Court has excluded one exhibit and a portion of another offered by defendants on grounds of hearsay, as reflected in a separate Opinion and Order issued this same day.

## I. FINDINGS OF FACT

Upon a careful consideration and evaluation of the testimony of all the witnesses and the documentary evidence admitted at trial, and making credibility findings as necessary and appropriate to resolve any material discrepancies in the testimony, the Court makes the following findings of fact:

### A. *Partido Revolucionario Dominicano Seccional of Washington, D.C.*

The PRD is one of three major political parties in the Dominican Republic. The PRD has authorized the establishment of chapters, or “seccionals,” outside of the Dominican Republic in order to provide a forum for political discussion and social and cultural interaction of Dominicans living abroad, as well as for individuals generally interested in issues related to the Dominican Republic. See Transcript of Trial, October 11, 2002 (“Tr.”) at 10:21-12:9 (H. Santos).<sup>2</sup> According to the general by-laws of the PRD, there is a procedure by which interested groups become authorized as official seccionals. Specifically, “[t]he Political Commission of the Party shall authorize in each case the creation and integration of the Sectionals outside of the country and in the Zones, along with their respective jurisdictions.” Defs.’ Ex. 30(b), Excerpt from the General Statutes of the Dominican Revolutionary Party (“By-laws”) ¶ 2; Tr. 91:2-5, 95:5-6 (F. Jimenez). The By-laws also provide that a federal committee in the United States shall exist “which, as the superior body within the hierarchy, shall

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<sup>2</sup> An official transcript was generated for the proceedings that took place on October 11, 2002. No official transcript exists for the November 19 and November 20, 2002 proceedings, however. Accordingly, citation to the transcript refers to testimony given on October 11, 2002. Citations to testimony given on November 19, 2002 and November 20, 2002 is designated accordingly.

coordinate the activities of the Party throughout all of North America,” including the activities of seccionals. See By-laws ¶ 1. The president of the Federal Committee during the relevant time period was Dr. Rafael M. Lantigua, who testified on defendants’ behalf.

Plaintiffs comprise a seccional of the PRD authorized by the Political Commission and established in 1982. It is run by a Board of Directors and sponsors various social events, political rallies, fundraisers and similar activities related to the Dominican Republic and the PRD. See Tr. at 11:21-22 (H. Santos). The seccional also participates in an official capacity in the nomination of the PRD candidate for the presidency of the Dominican Republic. See Tr. at 17:3-19:2 (H. Santos). Plaintiffs’ group has members from the District of Columbia, Maryland and Virginia. See Pls.’ Ex. 20(a), Seccional de Washington, Maryland & Virginia Lista de Militantes; Pls.’ Ex. 20(b), Programa de Revision y Apertura Del Registro de Militantes; Tr. at 73:10-21, 74:19-75:2 (A. Beriguete). The majority of plaintiffs’ members are from Maryland, and meetings are held throughout the greater metropolitan area including in Maryland and Virginia. See Tr. at 15:12-16:23 (H. Santos).

The official name of plaintiffs’ group at its inauguration in 1982 was Partido Revolucionario Dominicano Seccional of Washington, D.C. See Tr. at 32:1-4 (H. Santos). The organization began using the name Partido Revolucionario Dominicano Seccional Metropolitana de Washington D.C., Maryland y Virginia in 2000. See id. at 31:5-6. Individually, plaintiffs are three corporations: one incorporated in Washington D.C. on March 31, 2002, under the name “Partido Revolucionario Dominicano (PRD), Seccional Metropolitana de Washington-DC, Maryland y Virginia;” one incorporated in Virginia on December 1, 2000, under the name “Partido Revolucionario Dominicano (PRD), Seccional Metropolitana de Washington-DC,

Maryland y Virginia;” and one incorporated in Maryland on April 7, 2000, under the name “Partido Revolucionario Dominicano (PRD), Seccional Metropolitana de Washington-D.C., Maryland and Virginia, Ltd.” (collectively, “PRD-DC”). See Pls.’ Ex.1, Government of the District of Columbia Certificate of Incorporation (March 31, 2000); Pls.’ Ex. 2, Commonwealth of Virginia State Corporation Commission Certificate of Incorporation (December 1, 2000); Pls.’ Ex. 3, State of Maryland Certificate of Incorporation.

As an authorized seccional, plaintiffs have a non-exclusive license to use the name and insignia of the PRD in their publications and in the course of their activities. See Tr. at 19:3-10 (H. Santos); Defs.’ Ex. 34, Affidavit of Rafael A. Lantigua, M.D. (“Lantigua Aff.”) ¶ 11. A group may not use the name Partido Revolucionario Dominicano unless it officially has been approved by the PRD’s Political Commission as a seccional. See Tr. at 95:11-14; 127:8-10 (F. Jimenez).

B. *“Partido Revolucionario Dominicano, Seccional de Maryland y Virginia”*

In 1996, several individuals decided to form a new seccional separate from PRD-DC to be called “Partido Revolucionario Dominicano, Seccional de Maryland y Virginia,” (“PRD-MD/VA”). PRD-MD/VA focused on membership in Maryland and Virginia, although the group did not have a policy of rejecting individuals from Washington, D.C. See Rodriguez Test. (Nov. 19, 2002).<sup>3</sup> After assessing the potential membership base of a new seccional,

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<sup>3</sup> Defendants use all of the following names in reference to their group: (1) Partido Revolucionario Dominicano, Seccional del PRD De los Estados de Maryland y Virginia “Don Antonio Guzman Fernandez;” (2) Partido REVOLUCIONARIO Dominicano, Seccional del PRD De los Estados de Maryland y Virginia; (3) Partido REVOLUCIONARIO Dominicano, Seccional Maryland y Virginia “Don Antonio Guzman Fernandez;” (4) Partido REVOLUCIONARIO Dominicano, Seccional de Maryland y Virginia; (5) Seccional Maryland y

PRD-MD/VA applied to be an official seccional in January of 1999. See Defs.’ Ex. 10, Letter of Application; Tr. at 116:1-18 (F. Jimenez); Rodriguez Test. (Nov. 19, 2002). This application was rejected verbally by the then-PRD President Emmanuel Esqua Guerrero at a meeting in New York, and ultimately was never approved. See Tr. at 117:19-119:4 (F. Jimenez); Lantigua Test. (Nov. 19, 2002). PRD-MD/VA submitted a second application to become an authorized seccional in November 1999. See Defs.’ Ex. 11, Letter from PRD-MD/VA to PRD President Hatuey DeCamps requesting authorization of PRD-MD/VA as a seccional; Tr. at 117: 9-16 (F. Jimenez).<sup>4</sup>

While both Mr. Jimenez and Mr. Rodriguez testified that Dr. Lantigua had authorized PRD-MD/VA as a seccional, both witnesses admitted that the Federal Chairman is not authorized to do so; only the PRD Political Commission is. See Tr. at 94:15-20 (F. Jimenez); Rodriguez Test. (Nov. 19, 2002). Instead, the Federal Chairman’s role in the admission of new

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Virginia, Partido REVOLUCIONARIO Dominicano; and (6) Seccional P.R.D. \*Don Antonio Guzman.\* See Lantigua Aff. ¶ 8.

<sup>4</sup> Between 1996 and September 2000, PRD-MD/VA represented itself as a proposed seccional, and placed the word “projecto” -- or proposed -- in front of any announcement in which it used PRD-MD/VA or one of the group’s names. See Romero Test. (Nov. 20, 2002). Dr. Lantigua testified that although it is not mentioned in the By-laws, an “approved” proposed branch or proyecto may use the name and insignia of the PRD if it incorporates “projecto” in the name. See Lantigua Test. (Nov. 19, 2002). This testimony is unrefuted by plaintiffs, but there is no evidence other than defendants’ use of the title that PRD-MD/VA was an “approved” proposed seccional or what the PRD requires in order for a group to become an authorized proposed seccional. While Mr. Jimenez also discussed the use by PRD-MD/VA of the title “projecto” prior to September 2000 in describing the group’s effort to become an approved seccional, he did not offer any detail as to whether his group actually had been approved as a proposed seccional. See Tr. 110:25-114:15 (F. Jimenez). The Court therefore concludes that the use of “projecto” in any manner by defendants does not immunize PRD-MD/VA from plaintiffs’ claims with respect to the misuse of the name and insignia of the PRD. Furthermore, even if PRD-MD/VA was authorized to use the PRD name and insignia accompanied by “projecto,” it ceased using “projecto” in September 2000.

seccionals is to swear in the seccional after receiving “orders from the party in the Dominican Republic.” Tr. at 94:21-22 (F. Jimenez). Although several defense witnesses testified that the Federal Chairman received authorization to authorize PRD-MD/VA, see Tr. at 110: 21-24 (F. Jimenez); Romero Test. (Nov. 19, 2002); Rivera Test. (Nov. 20, 2002), this testimony is either conclusory and not supported by evidence or based on Dr. Lantigua’s assurances that PRD-MD/VA had been authorized by the PRD, which does not suffice to prove that authorization in fact had been given.<sup>5</sup>

In his pre-trial affidavit, Dr. Lantigua averred that “[t]he P.R.D. has by-laws that govern the way that the P.R.D. and committees, seccionales, and other sub-groups that are authorized pursuant to those By-laws . . . operate and conduct themselves.” Defs.’ Ex. 34, Lantigua Aff. ¶ 3. Dr. Lantigua also averred that as president of the Federal Committee, he serves as “the leader of the ‘Federacion de Seccionales,’ which authorizes and oversees the operations and activities of numerous ‘seccionales’ or branches around the country.” Id. ¶ 6. In his testimony at trial, however, Dr. Lantigua conceded that only the Political Commission makes decisions regarding authorization of seccionals. See Lantigua Test. (Nov. 19, 2002).<sup>6</sup>

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<sup>5</sup> Similarly, the fact that members of other seccionals within the United States treated PRD-MD/VA as an official seccional at the September 30, 2000 “inauguration” and at a subsequent meeting in New York City, see Lantigua Test. (Nov. 19., 2002), is irrelevant to whether PRD-MD/VA is in fact an authorized seccional.

<sup>6</sup> Although he did not discuss it in his affidavit, Dr. Lantigua also testified at trial that he had received a telephone call from the then-current PRD President Hatuey DeCamps informing him that PRD-MD/VA had been authorized as a seccional, but that he did not know the date or time of the call. See Lantigua Test. (Nov. 19, 2002). The Court orally ruled, however, that the call and its contents were inadmissible hearsay. Dr. Lantigua also testified that he had been informed by phone that other seccionals had been authorized, but he could not testify as to the details of those other calls.

Defendants have offered no evidence in the form of minutes of the meeting at which the Political Commission purportedly authorized PRD-MD/VA, the affidavit or testimony of any individual who attended such a meeting, or any official authorization document. Dr. Lantigua testified that he believed PRD-MD/VA had been approved, and that he would not have sworn in PRD-MD/VA had the group not been authorized by the Political Commission, but his statement of belief is insufficient to demonstrate authorization. See Lantigua Test. (Nov. 19, 2002). By contrast, Dr. Rafael Bonilla, General Secretary of the PRD, member of the Political Commission and official party spokesman, unequivocally stated in a pre-trial deposition that was admitted in evidence that PRD-MD/VA is not officially recognized as a seccional because it has never been approved by the Political Commission. See Pls.' Ex. 20, Deposition of Rafael S. Bonilla, Oct. 4, 2002 at 10:8-11:3, 14:21-17:23. Upon review of all the evidence the Court finds that there is no evidence before it that the Political Commission of the PRD officially authorized PRD-MD/VA to be an official seccional in accordance with the PRD By-laws, Dr. Lantigua's assurances notwithstanding.

Dr. Lantigua presided over a swearing-in ceremony for PRD-MD/VA on September 30, 2000. See Rodriguez Test. (Nov. 19, 2002). The invitation for the inauguration featured the name "PRD" together with PRD-MD/VA's name. See Defs.' Ex. 12(a) (invitation to inauguration event). The name and insignia of the PRD also were featured prominently on decorations displayed at the inauguration event itself. See Defs.' Ex. 12(b), Photographs of Inauguration (name and insignia of PRD prominently displayed at the event).

Following the September 30, 2000 inauguration party, PRD-MD/VA made an effort to gain members, raise funds, and work with non-profits in philanthropic endeavors. In



doing so, the group intended to expand what it considered to be PRD-DC's limited purpose beyond political activities. See Rodriguez Test. (Nov. 19, 2002). As part of this effort, PRD-MD/VA held several events for which it sent invitations or distributed flyers that featured the name and insignia of the PRD, including a celebratory inauguration party on December 1, 2000. See Rodriguez Test. (Nov. 19, 2002); Defs.' Ex. 15, Invitation to Dec. 1, 2000 event; Defs.' Ex. 16(a), flyer for Dec. 1, 2000 party; Defs.' Ex. 16(b)-(g) (letters of invitation to Dec. 1, 2000 party). The PRD insignia was prominently displayed at the December 1, 2000 party as well. See Defs.' Ex. 17(a)-(b) (photographs of Dec. 1, 2000 event).

PRD-MD/VA subsequently distributed a newsletter that featured the name and insignia of the PRD, see Defs.' Ex. 19(a) ("Seccional PRD "Don Antonio Guzman Fernandez" Maryland y Virginia" Boletin Informativo Mesual), and distributed invitations and flyers and held numerous events that prominently displayed the PRD name and insignia. These included: (1) a fundraiser sponsored by PRD-MD/VA (see Defs.' Ex. 19(b) (informational flyer for fundraiser)); (2) a letter of invitation to PRD president Hatuey DeCamps from Ivan Romero to attend a party in honor of the first anniversary of "inauguration" (see Defs.' Ex. 19©)); (3) the first anniversary party itself, at which the PRD name and insignia were displayed (see Defs.' Ex. 19(d) (photograph of event); (4) a calendar of 2001 events of PRD-MD/VA (see Defs.' Ex. 19(f)); and (5) a party honoring Dominican Mothers (see Defs.' Ex. 19(g) (invitational promotion)).

After PRD-MD/VA began advertising its events using the PRD name and insignia, individuals approached PRD-DC board members inquiring about the events. These

individuals were confused and assumed that PRD-DC was sponsoring the activities. See Tr. at 21:13-22:22, 26:6-13, 29:10-21. (H. Santos).<sup>7</sup>

On November 21, 2000, PRD-DC through counsel sent a letter to PRD-MD/VA asserting that the latter group was using the name and insignia of the PRD in violation of the law and requesting that PRD-MD/VA cease and desist using the name. See Pls.’ Ex. 7, November 21, 2000 Letter from Stanley H. Goldschmidt, Esq. to Dr. Guillermo Rivera. Dr. Rivera responded to the letter, stating that he did not “have a problem complying to [the] letter, but [he would] not accept any responsibility for other individuals who might use any stationery, material, cards, advertisements and the like. Therefore, [Dr. Rivera would] cease to distribute any of the items” delineated in Mr. Goldschmidt’s letter. Pls.’ Ex. 9, November 24, 2000 Letter from Dr. Guillermo Rivera to Stanley H. Goldschmidt, Esq. Dr. Rivera testified at trial that he foresaw no problem in complying with the letter because he interpreted it as instructing him not to use “Washington, D.C.” with respect to his group, PRD-MD/VA. See Tr. at 140:7-15 (G. Rivera). PRD-MD/VA did not cease using the name PRD or its insignia.

## II. DISCUSSION

Plaintiffs filed suit raising two claims: (1) a violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); and (2) common law trademark infringement. Specifically, plaintiffs argue that by using the name “Partido Revolucionario Dominicano, Seccional de Maryland y Virginia” or any of its counterparts and the PRD insignia without plaintiffs’ consent,

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<sup>7</sup> Defendants’ presentation of witnesses who testified that they have not seen any confusion between the two groups, see Rodriguez Test. (Nov. 19, 2002); Lantigua Test. (Nov. 19, 2002), does not enervate plaintiffs’ evidence that confusion between the groups existed.

knowledge or authorization, defendants have infringed on plaintiffs' exclusive license to use the name PRD and its insignia as an authorized seccional in the Washington, D.C. metropolitan area. Defendants counterclaim, raising identical claims and arguing that by using the name Partido Revolucionario Dominicano Seccional Metropolitana de Washington D.C., Maryland y Virginia rather than Partido Revolucionario Dominicano Seccional de Washington D.C., plaintiffs improperly expanded their name, and by doing so have infringed on defendants' authorized name. Both parties moved for a permanent injunction restricting the other from, *inter alia*, using the name and insignia of the PRD in the current form.

*A. Standard for Permanent Injunction*

In determining whether to enter a permanent injunction, the Court considers a modified iteration of the factors it utilizes in assessing preliminary injunctions: (1) success on the merits, (2) whether the plaintiffs will suffer irreparable injury absent an injunction, (3) whether, balancing the hardships, there is harm to defendants or other interested parties, and (4) whether the public interest favors granting the injunction. See National Ass'n of Psychiatric Health Systems, et al. v. Shalala, 120 F. Supp. 2d 33, 44 (D.D.C. 2002). See also Amoco Production Co. v. Village of Gambell, 480 U.S. 531, 546 n.12 (1987) ("The standard for a preliminary injunction is essentially the same as for a permanent injunction with the exception that the plaintiff must show a likelihood of success on the merits rather than actual success."); National Mining Ass'n v. U.S. Army Corps of Engineers, 145 F.3d 1399, 1408-09 (D.C. Cir. 1998) (demonstration of actual success on the merits required for permanent injunctive relief). The Lanham Act expressly provides that "courts vested with jurisdiction of civil actions arising under

this [Act] shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, . . . to prevent a violation under subsection (a), (c), or (d) of section 1125(a) of this title.” 15 U.S.C. § 1116(a).

## B. *Success on the Merits*

### 1. Section 43(a) of the Lanham Act

In order to prevail in a trademark infringement case under the Lanham Act, “the plaintiff must show (1) that it owns a valid trademark, (2) that its trademark is distinctive or has acquired a secondary meaning, and (3) that there is a substantial likelihood of confusion between the plaintiff’s mark and the alleged infringer’s mark.” Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. 473, 476 (D.D.C. 1996) (citing Sears, Roebuck and Co. v. Sears Financial Network, 576 F. Supp. 857, 861 (D.D.C. 1983)) (additional citation omitted). These protections extend to the names and symbols related to political organizations. See United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86, 90 (2d Cir. 1997).

When a tradename is not registered on the United States Principal Register of Trademarks, it can nonetheless benefit from Lanham Act protection. See Duggal v. Krishna, 554 F. Supp. 1043, 1044 n.4 (D.D.C. 1983) (“The Lanham Act’s proscription of unfair competition . . . is available to the owner of an unregistered mark.”). Here, both plaintiffs and defendants bring suit under 15 U.S.C. § 1125(a), which provides in relevant part that:

[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or

false or misleading representation of fact, which (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1). Courts have concluded that this section provides a cause of action to the licensee of a trademark or tradename against a competitor for improper use of the licensed mark.

See Twentieth Century Fox Film Corp. v. Marvel Enterprises, Inc., 277 F.3d 253, 260 (2d Cir.

2002); Quabaug Rubber Co. v. Fabiano Shoe Co., Inc., 567 F.2d 154, 160 (1st Cir. 1977)

(exclusive licensee of product in United States has standing under Section 1125(a) as one “who suffer[ed] adverse consequences from a violation”).

The analysis for unfair competition under Section 43(a) of the Lanham Act is essentially the same as the analysis for trademark infringement. “Where [the mark] is not inherently distinctive, the essential elements are the same for either a trademark infringement or unfair competition action.” American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. 244, 261-262 (D.D.C. 1980). In addition, “the remedy for unfair competition, injunctive relief, is the same as that provided by the infringement law.” Id. at 262. The Court therefore will apply the Sears, Roebuck infringement test to the parties’ claims.

#### a. Ownership of the Mark

The first prong of the Sears, Roebuck analysis requires a party to demonstrate “ownership” of the mark in question. In the absence of a registered trademark, the Court assesses the factual circumstances from which the claims arise in order to determine whether the party

claiming infringement or unfair competition has a cognizable interest in the mark or name in question. See Duggal v. Krishna, 554 F. Supp. at 1047 (where the mark in dispute was the name of a periodical, the court conducted inquiry as to which party owned the periodical). Here, the “ownership” question boils down to whether either group has a license from the PRD to use the name and insignia of the party. As the Court has found, plaintiffs as an authorized seccional have a non-exclusive license from the PRD to use the name and insignia of the PRD in their activities and publications. See supra at 4. Accordingly, the Court concludes that plaintiffs meet the first prong of the Sears, Roebuck test.

As the Court also has found, however, a group may not use the name Partido Revolucionario Dominicano or its insignia unless it officially has been approved by the Political Commission as a seccional. See supra at 5, 7. Because the Court found that plaintiffs were approved to use the name but that defendants failed to produce any evidence that the Political Commission of the PRD ever authorized PRD-MD/VA, see supra at 8, the Court concludes that defendants’ group does not have a license to use the name and insignia of the PRD. Defendants therefore fail to meet the first prong of the Sears, Roebuck standard, and their claim against plaintiffs fails.

b. Distinctiveness and Secondary Meaning

With respect to the second prong of the Sears, Roebuck test, the Court in Malarkey-Taylor stated:

The general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning. Generic and descriptive terms receive little or

no trademark protection, while suggestive, arbitrary or fanciful marks are viewed as inherently distinctive and entitled to varying degrees of protection.

Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 476 (quotation and citation omitted). See also The Appleseed Foundation, Inc. v. Appleseed Institute, Inc., 981 F. Supp. 672, 675 (D.D.C. 1997). A mark has secondary meaning “if it inspires an association in the minds of the relevant buying public between the name of the product and the product itself, or its source.” Duggal v. Krishna, 554 F. Supp. at 1047 (citing American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 255).

The existence of secondary meaning under Section 43(a) is a factual determination and, while there is no definitive list of criteria used to determine secondary meaning, courts do look to “(1) the duration and continuity of use of the mark, (2) the extent of advertising and promotion and amount of money spent thereon, (3) figures showing sales of plaintiff's products or number of people who have viewed it, and (4) identification of plaintiff's and defendant's respective markets.” American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 257. See also Russian Academy of Sciences, et al. v. American Geophysical Union, No. 98-2165, 1998 U.S. Dist. LEXIS 20598, at \*12 (D.D.C. Dec. 16, 1998). The relevant inquiry is not whether the general public associates a name with a product or a source, but rather whether the “relevant buyer class” does. American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 256. In this action, the question is whether persons in the Washington, D.C. metropolitan area who are interested in the PRD and its political activities associate the name and insignia of the PRD with plaintiff's group.

The Court concludes that plaintiffs have demonstrated that such an association exists between the name and insignia of the PRD and PRD-DC and that PRD-DC and its various corporate names thus have acquired secondary meaning. Plaintiffs have shown that since its inception in 1982 its large membership and like-interested individuals have looked to plaintiffs to represent them in matters related to the PRD, including in an official capacity in the PRD political conventions in the Dominican Republic. See supra at 4-5. The formal authorization of PRD-DC as a seccional underscores this connection because individuals interested in activities related to the PRD likely are aware of the existence of the “seccional” system and look to official seccionals to provide a local link to the PRD. In addition, defendants’ use of the name and insignia of the PRD in the same geographic area or “market” in connection with activities similar to those of PRD-DC, such as fundraisers for the PRD and events involving PRD officials, further evidences the secondary meaning and the goodwill attached to these marks. See Russian Academy of Sciences, et al. v. American Geophysical Union, 1998 U.S. Dist. LEXIS 20598, at \*13 (mimicking of plaintiff’s journal title in defendant’s marketing materials indicates secondary meaning in relevant target population).

c. Likelihood of Confusion

The third prong of the Sears, Roebuck test asks “whether the relevant purchasing public is likely to be confused by the use of the defendants’ mark.” Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 476. “The crucial focus of the inquiry is the effect of the defendant’s mark on prospective purchasers. If the [mark] is likely to have the effect of confusing purchasers into believing that the [the defendant's mark]



is somehow associated with [plaintiff's mark . . .] or if it would tend to cause purchasers to mistake the [defendant's mark] for [the plaintiff's mark] itself . . . the requirements for finding this element of infringement are satisfied.” American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 257. See also The Appleseed Foundation, Inc. v. Appleseed Institute, Inc., 981 F. Supp. at 675 (“[T]he Court looks at the effect that defendant’s use of the mark has or would have on prospective consumers within the relevant product market.”); Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 477 (“[T]he focus is on whether a similarity exists that is likely to cause confusion.”).

Here, plaintiffs have demonstrated that actual confusion occurred as a result of PRD-MD/VA using the PRD name and insignia. See supra at 9-10. And while a party need not demonstrate actual confusion in order to satisfy the third prong of the Sears, Roebuck test, “there can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion.” Russian Academy of Sciences, et al. v. American Geophysical Union, 1998 U.S. Dist. LEXIS 20598, at \*22 (quoting American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 258). See also The Appleseed Foundation, Inc. v. Appleseed Institute, Inc., 981 F. Supp. at 675 (“[E]vidence of actual confusion is substantial proof of this element.”); Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 477 (“[A]ctual confusion is substantial proof of the existence of the likelihood of confusion.”). Even if the evidence of actual confusion is not overwhelming, however, “the instances documented [by plaintiffs] demonstrate that confusion is likely.”

National Rural Electric Cooperative Association v. National Agricultural Chemical Association,  
26 U.S.P.Q 2d 1294, 1296 (D.D.C. 1992).

In assessing the likelihood of confusion, the Court may consider a number of factors. While not all of these factors need be present in every case, the factors include: (1) the strength of the plaintiff's mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) evidence of actual confusion; (5) the defendants' purpose or reciprocal of good faith in adopting its own mark;<sup>8</sup> (6) the quality of defendants' product; and (7) the sophistication of the buyers. See Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 477 (citing Polaroid Corp. v. Polarad Elec. Corp., 287 F.2d 492, 495 (2d Cir. 1961)).

In this case, plaintiffs' use of the name and insignia of the PRD is long-standing and strong. As the only official seccional of the PRD in the Washington, D.C. area for over 22 years, thirteen of which were prior to the creation of PRD-MD/VA, it is likely that the relevant population presumed that PRD-DC was the entity sponsoring events in this area that were advertised with the name and insignia of the PRD.<sup>9</sup> The two groups' names are strikingly similar; they differ only in the inclusion of Washington, D.C. in PRD-DC's name. PRD-MD/VA uses the name and the insignia of the PRD in the same manner as PRD-DC does, as part of its

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<sup>8</sup> This factor also is characterized as "the intent of the junior user." The Appleseed Foundation, Inc. v. Appleseed Institute, Inc., 981 F. Supp. at 675.

<sup>9</sup> The fact that PRD-MD/VA included "Maryland y Virginia" in its name would not necessarily indicate to the relevant population that it was a new group, especially to those members of PRD-DC who reside in Maryland and Virginia. While PRD-DC may have added to the confusion between the groups by adding "Metropolitana de Washington D.C., Maryland y Virginia," to its name in 2000, defendants' lack of authority to use the PRD name and insignia in the first instance diffuses this argument.

official name and in printed materials relating to the group. The target populations reside in the same metropolitan area and overlap almost completely. PRD-DC has members from Washington, D.C., Maryland and Virginia; while PRD-MD/VA targets members only in Maryland and Virginia, it does not officially exclude Washington, D.C. residents. *See supra* at 5. In addition, the purpose of PRD-MD/VA is similar to that of PRD-DC in providing an official link between the residents of the Washington, D.C. metropolitan area in Maryland and Virginia to the PRD. *See supra* at 5. Finally, plaintiffs have demonstrated through testimony presented at trial that there is actual confusion between the two groups in the minds of the relevant population. *See supra* at 9-10.

In addition to all of these factors, there is some evidence of intent to infringe -- or bad faith -- on the part of PRD-MD/VA in its continued use of the PRD name and insignia even after Mr. Rivera's receipt of plaintiffs' cease and desist letter of November 21, 2000. *See supra* at 10. *See also Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association*, 929 F. Supp. at 478 (bad faith evidenced in refusal to cease and desist use of mark after notification of infringement); *National Rural Electric Cooperative Association v. National Agricultural Chemical Association*, 26 U.S.P.Q 2d at 1297 (same).

Based upon its analysis of the foregoing factors, the Court concludes that plaintiffs have met the third prong of the *Sears, Roebuck* standard. The plaintiffs therefore have demonstrated that defendants are in violation of Section 43(a) of the Lanham Act.

## 2. Common Law Trademark Infringement

The analysis with respect to the parties' common law trademark infringement claims mirrors the analysis conducted for federal statutory trademark/unfair competition claims. See Russian Academy of Sciences, et al. v. American Geophysical Union, 1998 U.S. Dist. LEXIS 20598, at \*10; see generally American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 262. The resolution of the common law claim in plaintiffs' favor and to defendants' detriment therefore flows directly from the Court's resolution of the Lanham Act claim.

### *C. Irreparable Harm*

Trademark infringement "by its very nature causes irreparable injury." The Appleseed Foundation, Inc. v. Appleseed Institute, Inc., 981 F. Supp. at 677. See also Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 478 (citing Crime Control, Inc. v. Crime Control, Inc., 624 F. Supp. 579, 581 (D.D.C. 1984)) (trademark infringement raises a presumption of irreparable harm). In this instance, PRD-DC is claiming that the infringement has resulted in its loss of control over its reputation and in injury to its goodwill, which, they argue, are harms that are not compensable in money damages and therefore justify injunctive relief. See Russian Academy of Sciences, et al. v. American Geophysical Union, 1998 U.S. Dist. LEXIS 20598, at \*30 (citing Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 478); American Association for the Advancement of Science v. Hearst Corp., 498 F. Supp. at 262. As the court of appeals has noted, "[s]ource, reputation and good will are as important to

eleemosynary institutions as they are to business organizations. . . . [An organization's] financial credibility to raise funds, its general reputation, the reputation of those managing and supporting it, are all at stake if its name is used by some other organization and the two become confused in the minds of the public.” American Gold Star Mothers, Inc. v. National Gold Star Mothers, Inc., 191 F.2d 488, 489 (D.C. Cir. 1951).

The fact that PRD-MD/VA holds itself out as an official seccional has caused confusion among those individuals who seek to be involved in an authorized seccional in the Washington, D.C. metropolitan area. It also has resulted in the donation of funds for PRD-related activities to an unauthorized group. See supra at 8-9. In addition, to the extent that PRD-MD/VA is attempting to broaden its scope of activities beyond that of PRD-DC, see supra at 8-9, such an effort may be construed by members of the relevant population as a shift of PRD-DC's mission to PRD-DC's detriment.

Confusion among political organizations risks an additional, unique harm. As the Second Circuit concluded:

a political organization that adopts a platform and endorses a candidate under a trade name performs the valuable service of communicating to voters that it has determined that the election of those candidates would be beneficial to the objectives of the organization. . . . If different organizations were permitted to employ the same trade name in endorsing candidates, voters would be unable to derive any significance from an endorsement, as they would not know whether the endorsement came from the organization whose objectives they shared or from another organization using the same name. . . . The resulting confusion would be catastrophic; voters would have no way of understanding the significance of an endorsement or position taken by parties of recognized major names.

United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d at 90-91.

Because seccionals have a formal role in the nomination of the PRD presidential candidate, PRD-MD/VA's continued presentation of itself as an authorized seccional risks not only confusion among the relevant population as to PRD-DC's positions, but also risks the compromise of the PRD political process in the Dominican Republic. The Court therefore concludes that plaintiffs have demonstrated irreparable harm and a threat of continuing irreparable harm should PRD-MD/VA continue to hold itself out as an authorized seccional.

*D. Balance of Harms and the Public Interest*

The Court also concludes that the balance of harms weighs in plaintiffs' favor. Plaintiffs have functioned under the name and insignia of the PRD for over twenty years. The designation as an authorized seccional comes with benefits and responsibilities that have great significance for its members, including their official representation in the political process in the Dominican Republic. The undermining of the group's reputation and goodwill and the impact on its members put the receipt of those benefits and the fulfillment of those responsibilities at risk. By contrast, any harm that defendants claim is mitigated by the fact that it is not authorized to function under the name and insignia of the PRD in the first place and has been in existence for a much shorter period of time. "[T]he balance of harms cannot favor a defendant whose injury results from the knowing infringement on the plaintiff's trademark." Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Association, 929 F. Supp. at 478. See also Russian Academy of Sciences, et al. v. American Geophysical Union, 1998 U.S. Dist. LEXIS 20598, at \*30; The Appleseed Foundation, Inc. v. Appleseed Institute, Inc., 981 F. Supp. at 675. Finally, because PRD-DC is the only authorized seccional in the metropolitan area, there

is a public interest in preventing PRD-MD/VA from representing itself as a competing authorized seccional.

### III. CONCLUSION

For the foregoing reasons, the Court concludes that plaintiffs have met their burden of demonstrating their entitlement to a permanent injunction. It therefore will grant plaintiffs' motion and will deny defendants' motion. An Order consistent with this Opinion shall issue this same day.

SO ORDERED.

DATE:

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PAUL L. FRIEDMAN  
United States District Judge

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

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PARTIDO REVOLUCIONARIO DOMINICANO  
(PRD) Seccional Metropolitana de Washington-DC,  
Maryland y Virginia, et al.,

Plaintiffs,

v.

“PARTIDO REVOLUCIONARIO DOMINICANO,  
Seccional de Maryland y Virginia,” et al.,

Defendants/Counterclaimants.

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ORDER

For the reasons stated in a separate Opinion issued this same day, it is hereby

ORDERED that plaintiffs’ Motion for a Permanent Injunction [35-1] is

GRANTED; it is

FURTHER ORDERED that Defendants/Counterclaimants’ Motion for a

Permanent Injunction [36-1] is DENIED; it is

FURTHER ORDERED that defendants are enjoined from using the name

“Partido Revolucionario Domincano” or any variation thereof (see Opinion at 5-6 n.3), or the  
insignia thereof; it is

FURTHER ORDERED that defendants are enjoined from distributing materials

that incorporate in any manner the name “Partido Revolucionario Domincano” or any variation  
thereof, or the insignia thereof; it is



FURTHER ORDERED that defendants are enjoined from engaging in fundraising or any other activities intended to solicit money or donations from the public while using the name “Partido Revolucionario Dominicano” or any variation thereof, or the insignia thereof; it is

FURTHER ORDERED that defendants are enjoined from attempting to register members for any organization through the use of the name “Partido Revolucionario Dominicano” or any variation thereof, or the use of the insignia thereof; it is

FURTHER ORDERED that defendants are enjoined from implying in any manner whatsoever that “Partido Revolucionario Dominicano, Seccional de Maryland y Virginia” is an authorized seccional of the Partido Revolucionario Dominicano, or that any such organization is affiliated with plaintiffs’ organization or the Partido Revolucionario Dominicano; it is

FURTHER ORDERED that on or before April 14, 2004, plaintiffs shall file a memorandum indicating whether final judgment in this matter should be entered; and if final judgment is not appropriate, delineating what issues remain for resolution; and it is

FURTHER ORDERED that defendants shall file a response to plaintiffs’ memorandum on or before April 26, 2004.

SO ORDERED.

DATE:

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PAUL L. FRIEDMAN  
United States District Judge